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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,603

06/27/2003

Curtis A. Richardson

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DELPHI TECHNOLOGIES, INC.

M/C 480-410-202

PO BOX 5052

TROY, MI 48007

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/607,603

Applicant(s)

RICHARDSON ET AL.

Examiner

Raymond Alejandro

Art Unit

1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 5-7.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Raymond Alejandro
Primary Examiner
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Response to Arguments

1. Applicant's arguments filed 04/17/06 have been fully considered but they are not persuasive.
2. At the outset, the examiner requests further clarification as to whether the reference to "Nadia" is an inadvertent error in nature; and whether or not the reference to Nadia is intended to mean "Nagai". Otherwise, applicant's discussion of Nadia is completely irrelevant to the present application as the examiner is not aware of a so-called reference or a prior art named "Nadia" in the instant application.
3. Applicant has argued that *"The spacer 5a is a critical component of Nadia necessary to maintain a constant distance between separators 2"* and *"the spacer 5a in Nadia defines the gap between the adjacent components and is formed of solid metal. Because of the metal spacer, the air spaces are nonfunctional"* and *"Because of the spacer, Nadia does not have a pillow structure, and nothing in Nadia would suggest to eliminate the metal spacer to allow the space to act as a pillow structure"*. First, the examiner contends that the transitional language recited in the present claims "comprising" is an open-ended clause and does not exclude the inclusion of additional features or members. Thus, applicant's arguments pointing that the pillow structure of Nagia does not meet the claimed requirement of applicant's pillow structure because Nagai's structure does include a spacer between the adjacent components have little merit in view of the open-ended language allowing the incorporation of more features or components. Furthermore, the examiner indicated in the previous office action that the empty spaces located at both opposite sides of the spacer fully meet the requirement of "a gas-filled chamber enclosed with said first and second sheet metal elements". In simple terms, the two empty spaces therein

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compensate for the claimed gas-filled chamber. Additionally, note that the present claims does permit the gas-filled chamber to include additional components/elements; and does not require that the gas-filled chamber be entirely filled of air, that is to say, the chamber filled only with air. Thus, it is noted that Nagai's pillow structure provides the necessary functional and structural interrelationship to satisfy the claimed requirements.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a) *"the structure is hard and is neither soft nor compressible nor any other property attributable to a pillow"*; b) *"forming a tight seal, and second to compensate for variations in the load during operation"*; c) *"Applicant's assembly is adapted for higher operating temperatures than polymeric gaskets"*; d) *"The combination of the gas-filled chamber and the diffusion bonding creates a hermetic seal"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. In response to applicant's argument that: a) *"The spacer is a critical component of Nadia necessary to maintain a constant distance between the separators 2 and 3"*; and b) *"Applicant's invention is uniquely able to avoid the problems of a solid metal spacer across the gap..., and to eliminate polymeric materials that tend to degrade at the elevated operating temperature"*, the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).


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6. In response to applicant's arguments that: a) *"the assemblies in both Nadia and Wakamatsu require elastomeric material between the metal and the adjacent components"*; b) *"If the sheets in Nadia were replaced with metal, the gap would be bridged by solid metal"*; c) *"The skilled practitioner, ... is not lead to replace the elastomeric sheet in Nadia with metal..."*; d) *"Thus, JP '783, like Nadia, forms a gasket with non-metallic material in contact with the adjacent components. Even if combined, JP '783 does not leas the practitioner to replace the polymer sheets with metal sheets"*, e) *"Franklin et al is applied to show a gasket for a fuel cell that includes a plastic polymer material, an elastomeric material, a composite material, a metallic material, a foam material, or combinations thereof"*, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. (*Emphasis supplied*→) Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Moreover, as stated earlier, the language of the present claims calls for open-ended transitional terms/phrases *"comprising"*. As such, as long as the combination of Nagai and Wakamatsu does teach or disclose the use of the metal sheet elements for gasketing purposes in the fuel cell assembly, and absent further exclusionary proviso or

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language limiting the present claims not to include additional elements such as elastomeric materials therebetween, the examiner avers that the above-mentioned combination of Nagai and Wakamatsu does exhibit substantially the same pillow structure, in terms of configuration and functionality, as applicant's pillow structure. Additionally, the combination of Nagai and Wakamatsu does envision the formation and creation of a pillow structure having the same structure and material components as the pillow structure of the applicant; and furthermore, the combination of Nagai and Wakamatsu does lead a skilled artisan to embody and envision a pillow structure having metal sheet elements and a gas-filled chamber as instantly claimed.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



RAYMOND ALEJANDRO
PRIMARY EXAMINER